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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,449	09/28/2001	Takua Nakamura	WEN-008	1688

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EXAMINER

FARAH, AHMED M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/964,449

Applicant(s)
Nakamura et al.

Examiner
A. Farah

Art Unit
3739



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- (F) 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ ~~Claim(s) 1-10~~ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 6) ☐ Other:

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DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the term "means" in lines 6, 8, and 10-12 is an illegal phraseology. Furthermore, it contains more than 150 words. Correction is required. See MPEP § 608.01(b).
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

✓
ok

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Applicant's claim 1, and dependent claims 2-7 thereafter, recite '*an apparatus for correcting refractive error of the eye by ablating corneal tissue.*' However, they fail to disclose an ablation unit, which is essential to provide the ablative energy. Correction is required.

✓
OK

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amano et al. 6,190,374 B1 in view of Lieberman et al. U.S. Patent 6,416,179 B1.

Amano et al. disclose a corneal surgery apparatus for correcting refractive error of the eye by ablating corneal tissue with a laser beam, the apparatus comprising:

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an ablation system comprising a laser light source **1** for emitting ablative laser beams, and an irradiation optical system (**2-9, 14, and 16**) for irradiating the emitted laser beam onto the cornea;

an input means **21** for inputting refractive power data necessary for the desired correction; determining means (**see claim 1**) for determining the corneal shape based on the information inputted by said input means, and for obtaining ablation amount of a part of the cornea (calculating means for converting the inputted refractive power data to obtain ablation data as presently claimed); and

control means **20** for controlling an ablation amount of the corneal tissue based on the obtained ablation data.

As to claim 9, their irradiation optical system includes: a circular aperture **7** of which opening diameter is changeable; a projection lens **14**, which projects the aperture onto the cornea; a shifting unit **8**, which displaces a region to be irradiated with the laser beam from a center of an optical zone on the cornea; and a rotator **6**, which rotates the laser beam. See Fig. 1.

However, although Amano et al. determine the desired corneal correction prior to irradiation, they do not teach the process in which the corneal irregularity of the patient is measured. In particular, they do not teach that the desired correction is determined by fitting the patient's eye with a contact lens so as to determine the desired correction as presently claimed.

However, Lieberman et al. teach an alternative apparatus and method for performing corneal ablation in which contact lens is used to determine the desired vision correction.

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Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Amano et al. in view of Lieberman et al. and use contact lenses in order to determine the desired vision correction prior to ablation. The use of lenses or contact lenses to correct vision disorders is well known in the art. Thus, since corrective surgery using a laser beam is an irreversible process, the use of contact lenses to determine the desired correction prior to ablation would provide to the surgeon with a safe and reliable data.

Conclusion

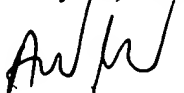
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,364,483 B1 to Grossinger et al.; U.S. Patent 5,786,883 to Miller et al.; and U.S. Patent 6,296,867 B1 to Peyman teach methods for correcting vision disorders using contact lenses, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703) 746-3368.

A. M. Farah

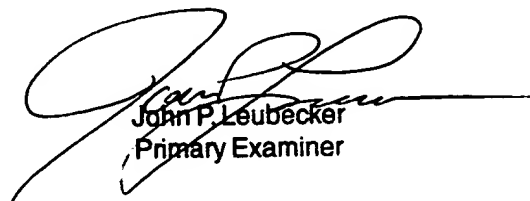
Patent Examiner (Art Unit 3739)

January 13, 2003



Linda C. M. Dvorak

Supervisory Patent Examiner



John P. Leubecker
Primary Examiner